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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 10/728,439  | 12/05/2003  | Scott A. Burton      | 59405US002                   | 9418             |
| 32692   | 7590        | 07/19/2006           |                              |                  |
| 3M INNOVATIVE PROPERTIES COMPANY<br>PO BOX 33427<br>ST. PAUL, MN 55133-3427 |             |                      | EXAMINER<br>RONESI, VICKEY M |                  |
|   |             |                      | ART UNIT<br>1714             | PAPER NUMBER     |

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                           |                  |
|------------------------------|---------------------------|------------------|
| <b>Office Action Summary</b> | Application No.           | Applicant(s)     |
|                              | 10/728,439                | BURTON ET AL     |
|                              | Examiner<br>Vickey Ronesi | Art Unit<br>1714 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 May 2006.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10, 12-51, 53-55 and 58-93 is/are pending in the application.

4a) Of the above claim(s) 61, 67-69, 90, 92 and 93 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10, 12-51, 53-55, 58-60, 62-66, 70-89 and 91 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/3/06.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. All outstanding objections and rejections, except for those given below, are withdrawn in light of applicant's amendment filed 5/3/2006.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. The new grounds of rejection are necessitated by applicant's amendment to further limit the claims with the specific amount of water. Thus, the following action is properly made final.

#### *Claim Rejections - 35 USC § 112*

4. Claims 46 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are to a composition, which cannot have structure, and therefore cannot be in the form of a film or a foam. If an extruded film or foam is intended to be claimed, the claims should be to an extruded film or foam and not to a composition.

#### *Claim Rejections - 35 USC § 103*

5. Claims 1-4, 6-9, 12, 19-39, 42-45, 48, 49, 50, 53, 55, 58-60, 75, and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asmus (US 5,270,358) alone or in view of Laurin et al (US 4,603,152).

The discussion in paragraph 6 of Office action mailed 11/3/2005 is incorporated here by reference.

With respect to the amount of water, see Table II in col. 24 wherein the amounts of deionized water range from 0 to 56 wt %, e.g., 13 wt % (Example 9).

6. Claims 5, 10, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asmus (US 5,270,358) alone or in view of Laurin et al (US 4,603,152) and further in view of Ahmed et al (US 6,458,877).

The rejection is adequately set forth in paragraph 7 of Office action mailed 11/3/2005 and is incorporated here by reference.

7. Claims 13-18, 84-87, and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asmus (US 5,270,358) alone or in view of Laurin et al (US 4,603,152) and further in view of Yan et al (US 2003/0185889).

The rejection is adequately set forth in paragraph 8 of Office action mailed 11/3/2005 and is incorporated here by reference.

8. Claims 62, 64-66, 70, 72-74, 76-78, and 80-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asmus (US 5,270,358) alone or in view of Laurin et al (US 4,603,152) and further in view of Bao et al (CN 1308102, abstract).

The rejection is adequately set forth in paragraph 9 of Office action mailed 11/3/2005 and is incorporated here by reference.

9. Claim 79 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asmus (US 5,270,358) alone or in view of Laurin et al (US 4,603,152) and further in view of Bao et al (CN 1308102, abstract) and Ahmed et al (US 6,458,877).

The rejection is adequately set forth in paragraph 10 of Office action mailed 11/3/2005 and is incorporated here by reference.

10. Claims 63 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asmus (US 5,270,358) alone or in view of Laurin et al (US 4,603,152) and further in view of Bao et al (CN 1308102, abstract) and Antelman (US 6,436,420).

The rejection is adequately set forth in paragraph 11 of Office action mailed 11/3/2005 and is incorporated here by reference.

### ***Double Patenting***

11. Claims 1-10, 12, 19-51, 53-55, 58-60, 75, 88 and 89 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15, 19-21, 26-39, 40-46, 49, 51, 53-63, and 70 of copending Application No. 10/728,577 (published as US 2004/0180093) alone or in view of Laurin et al (US 4,603,152).

The discussion in paragraph 12 of Office action mailed 11/3/2005 is incorporated here by reference.

With respect to the amount of water in the composition, note claims 19 and 40 of US appl. '577.

With respect to water be removed, note claim 26 of US appl. '577.

12. Applicant was advised in paragraph 13 of the Office action mailed 11/3/2005 to supply a statement of common ownership at the time of invention to preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g). Applicant has not supplied such a statement and therefore the following 35 U.S.C. 103(a) rejection based upon 35 U.S.C 102(f) or (g) is set forth below. It is suggested that applicant submit a statement such as, "Application X and Application Y were, at the time the invention of Application X was made, owned by Company Z." See MPEP § 706.02(l)(2).

13. Claims 1-10, 12, 19-51, 53-55, 58-60, 75, and 89 are rejected under 35 U.S.C. 103(a) as being obvious over commonly assigned copending Application No. 10/728,577 (published as US 2004/0180093).

The discussion set forth in paragraph 11 above is incorporated here by reference.

#### *Response to Arguments*

14. Applicant's arguments filed 5/3/2006 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that the process in the product-by-process claims provide for a different product; (B) that Asmus does not teach particle sizes of the gel particles less than 10 microns because it only exemplifies particle sizes between 25 and 200 microns; and (C) that the solubility of silver oxide is not intrinsically at least 0.1 gram per liter as stated by the examiner.

With respect to argument (A), applicant has not shown any difference with evidence that the product of Asmus is different than that presently claimed. As a practical matter, the Patent

Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.” *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

With respect to argument (B), the exemplified particles are to the hydrated particles and therefore would be larger than the presently claimed nonhydrated particle size. Regardless, case law holds that “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others.” *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967).

With respect to argument (C), the examiner agrees that the water solubility of silver oxide is not at least 0.1 gram per liter. Nevertheless, the presently claimed water solubility is not to the water solubility of silver oxide, rather, it is to the precursor compound of silver oxide. These limitations are considered to be part of process in the product-by-process claims given that the final product obtained is silver oxide and hence are not given patentable weight. With respect to the process claims, the examiner’s position remains that the silver oxide precursor has the presently claimed water solubility of at least 0.1 gram per liter.

### *Conclusion*

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/6/2006  
Vickey Ronesi



*Vasu Jagannathan*  
VASU JAGANNATHAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700